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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	0054-011P1	5831
40972 7590 05/20/2009 HENNEMAN & ASSOCIATES, PLC 714 W. MICHIGAN AVENUE THREE RIVERS, MI 49093				
EXAMINER				
RETTA, YIHDEGA				
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3622				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/606,729

Applicant(s)

DONIAN ET AL.

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-122 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-122 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to amendment filed February 27, 2009. Applicant amended claims 1, 43, 50, 53, 57, 62-81, 101, 102, 107 and added claims 110-122. Claims 1-122 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 107 and 108 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 107 is not directed to a process, as there is no method step; it is not directed to a system, as there is no system component. The invention seems to be directed toward an article of manufacture, however, signals, data structures or computer programs not embodied in computer-readable media executable by a computer are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. Data structure or signal not claimed as embodied in computer-readable media is descriptive material per se and is not statutory because they are neither physical nor statutory process. Such claimed signals do not define any structural and functional interrelationships between a computer code and other claimed elements of a computer, which permit the computer's program to be realized (see MPEP section 2106). The amended claim recites a data structure comprising of codes or fields which is just software or program per se.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 20, 50-52, 54, 61, 117 and 118 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites "said step of receiving at least one ad file includes receiving a plurality of ad files". It is unclear how receiving of one file can include receiving of more than one file.

Claim 20 also recites "said step of receiving at least one ad file includes receiving a plurality of ad files" and "said step of receiving input indicative of user's selection of at least one media file includes receiving a list of media files". It is unclear how receiving of one file can include receiving of more than one file, and step of receiving input indicative of user's selection of one media file can include receiving a list of media files. Claims 54 and 71 are also rejected for the same reason.

It is unclear what applicant intends to claim.

Claim 51 recites a method according to Claim 50, wherein said step of presenting said media file content to said user includes: decrypting said media file. Claim 50 however does not recite the media being encrypted therefore, it is unclear how unencrypted file can be decrypted. Claims 52, 117 and 118 are also rejected for the same reason.

Claim 61 recites "relaxing the requirement for presenting said ad file for the remainder of a single media presentation session after said ad file has been presented". Claim 1 recites receiving at least one ad file, selecting at least one media file, storing said media file, and presenting said stored media file content and said stored ad file content. Therefore, it is unclear

what applicant meant by relaxing the requirement for presenting said one ad file with one media file.

Claim 20 recites the limitation "said step of receiving a copy of media file". There is insufficient antecedent basis for this limitation in the claim. Claim 1 recites "receiving said media file".

Claim 50 is also rejected for the same reason.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 9-14, 17-28, 30-38, 41, 44-67, 70-85, 89-111 and 114-116 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Knepper et al. (2001/0042249).

Regarding claims 1, 62, 81, 102, 103, 107 and 108, Knepper teaches receiving at least one ad file; *storing said at lease one ad file in electronic device*; receiving input indicative of a user's selection of at least one media file; receiving a media file *separately from the ad file*; *storing said media file in the electronic device* and presenting said *stored* media file content and said *stored* ad file content to said user *sequencing said stored media file content and stored ad file content in said media player* (see [0008]-[0014], [0029], [0030], [0041]).

Regarding claims 2, 3, 63, 64, 82 and 83, Knepper teaches receiving another ad file; and re-presenting said media file content to said user with said another ad file content; receiving a plurality of ad files; and said step of presenting said ad to said user includes selecting said ad file from said plurality of ad files (see [0029], [0036], [0041], [0065]-[0068], [0081]).

Regarding claims 4-6, 65, 66, 84 and 85, Knepper teaches wherein said ad file is selected based at least in part on said media file content; receiving demographic information from said user; and wherein said ad file is selected at least in part based on said user demographic information; wherein said ad file is selected based at least in part on a marketing preference (see [0063]).

Regarding claims 9-14, 67, 70, 86 Knepper teaches wherein said ad file is selected based at least in part on a position of presentation of ad file content with respect to said media file content; based at least in part on a position of presentation of said ad file content with respect to other ad file content; based at least in part on a number of said media files to be presented; based at least in part on other ad files being presented with said media file content; based at least in part on a format of said media file content; (see [0080]-[0085]).

Regarding claims 17, 18, 70, 89, 90, 111, Knepper teaches further comprising making a record of ad files that have been presented to said user; transmitting said ad file presentation records to a provider of said ad files (see [0037], [0041]-[0077]).

Regarding claims 19-23 and 71-73, 91-93, Knepper teaches selecting subsequent ad files based at least in part on said ad file presentation records; receiving a plurality of ad files; said step of receiving input indicative of a user's selection of at least one media file includes receiving a list of media files; and said step of receiving a copy of said media file includes receiving a copy

of each media file in said list of media files; wherein said step of resenting said media file content with said ad file content includes arranging said ad files into ad blocks; presenting the content of said media files included in said list; and interrupting the presentation of said media file content with the presentation of the content of said ad blocks at predetermined points; altering the order of presentation of the content of said media files responsive to input from said user; and altering said predetermined points for presenting said ad block content based on the altered order of presentation of the content of said media files; further comprising: receiving input indicative of said user's desire to re-present the media files included in said list; generating new ad blocks; and presenting said media file content with the content of said new ad blocks (see [0008]-[0014], [0029], [0030], [0041], [0055], [0080]-[0082]).

Regarding claims 24-28, 30, 74 and 94-96, Knepper teaches altering the order of presentation of the content of said media files responsive to input from said user; and altering said ad block content based on the altered order of presentation of the content of said media files; wherein said step of presenting said media file content and said ad file content includes associating an ad requirement with said media file; and presenting sufficient ad file content to satisfy said ad requirement; wherein said ad requirement depends at least in part on the length of said associated media file content; wherein said ad requirement is predetermined for said associated media file; wherein a value indicative of said ad requirement is included in said associated media file; wherein an ad requirement associated with a particular media file is set to indicate that no ad content is required after said particular media file content has been presented with ad file content a predetermined number of times; wherein said ad requirement depends at

least in part on a service level associated with said user; (see [0008]-[0014], [0034]-[0037], [0041], [0052], [0084]).

Regarding claims 31-38, 75-77, 97, 98, 114, 115 Knepper teaches said media file content is presented in a first format; and said ad file content is presented in a second format different from said first format; broadcast, said first format is print and the second format is audio; wherein presenting said media file content and said ad file content includes presenting subsequent pages of said media file content, responsive to user input, while said ad file content is being presented; wherein said media file content and said ad file content are both presented in the same format; wherein said media file content and said ad file content are both presented in audio format; wherein said media file content and said ad file content are both presented in video format; wherein said media file comprises a real time; wherein said media file content and said ad file content are both presented in print format (see [0025], [0037]-[0040], [0049]-[0059], [0092], claims 1-9).

Regarding claim 41, Knepper teaches wherein said media file is received from the provider of said ad file (see [0026]-[0028]);

Regarding claim 44 Knepper teaches receiving updated ad files for use with subsequent presentation of media files (see [0029]-[0030]).

Regarding claims 45-54, 78, 79, 99, 101, 117, 118 and 101, Knepper teaches receiving media file identifiers associated with media files that should no longer be presented; further comprising receiving a new media file identifier associated with a new media file that should be substituted for an existing media file; further comprising associating an identifier with each media file, said identifier being uniquely indicative of a work of authorship contained in said

media file; wherein said step of receiving a copy of said media file includes receiving a copy of said media file *in a controlled access format*; decrypting said media file; and providing said decrypted media file to a media player; further comprising restricting access to said decrypted media file; wherein said step of receiving said ad file includes receiving a copy of said ad file in a controlled access format; said step of presenting said media file content and said ad file content includes dividing said media file into a plurality of segments, and presenting ad file content between said segments (see [0061]-[0070])

Regarding claims 55-57, 80 and 100 Knepper teaches presenting a graphical user interface representing a media player to said user, said interface including: a first tab indicative of a first media type; and a second tab indicative of a second media type; and whereby user selection of said first tab results in the presentation of an active window for the presentation of a media file of said first type, while a media file of said second type is presented in background (see [0038]-[0040]); wherein the first media file is print and second is audio (see [0025], page 10, claims 1-9)

Regarding 58-61, 89, 90, 114, Knepper teaches further comprising making a record of media files that have been presented to said user; transmitting said media file presentation records to a provider of said ad files; further comprising selecting subsequent ad files based at least in part on said media file presentation records; requiring that said ad file content be presented in order to present said media file content; and relaxing the requirement for presenting said ad file for the remainder of a single media presentation session after said ad file has been presented (see [0037], [0041]-[0077], [0080]-[0084]).

Regarding claims 104-106 Knepper teaches providing media files containing copyrighted works; providing ad files; providing a media player operative to combine and present the content of said media files with the content of said ad files; and providing a free license to consumers to present said media files and said ad files with said media player; further comprising authorizing said consumers to reproduce and transfer said media files free of charge; monitoring the presentation of said ad files to said consumers; and conferring a benefit on particular ones of said consumers based at least in part on the presentation of said ad files to said particular consumers (see [0008]-[0014], [0029], [0030], [0041]).

Regarding claims 107 and 108, Knepper teaches receiving at least one ad file; receiving input indicative of a user's selection of at least one media file; receiving a copy of said media file; and presenting said media file content and said ad file content to said user; including code for causing an electronic device to present said media file to a user (see [0008]-[0014], [0029], [0030], [0041]).

Regarding claims 109, 110, Knepper teaches wherein said ad file is selected based in part on characteristic of the user (see [0012], [0029]-[0030]-[0040]-[0041]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 8, 29, 39, 40, 42, 43, 112 and 113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper further in view of Strietzel (US 6,950,804).

Regarding claims 7 and 8, Strietzel teaches wherein said ad file is selected based at least in part on a geographic location or time of day (see col. 4 lines 14-33, col. 10 lines 1-67, col. 11 lines 1-35, col. 14 lines 59-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the advertisement of Knepper based on location or time of the day in order to provide targeted advertising, as taught in Strietzel.

Regarding claim 29, Strietzel teaches wherein an ad requirement associated with a particular media file is set to indicate that no ad content is required after said particular media file content has been presented with ad file content a predetermined number of times (see col. 4 lines 1-33, col. 10 lines 47-67). Strietzel teaches advertisement could only be added when a user accesses a particular content item for the first time and possibly a few subsequent times or provide the user with an option to purchase the content item. It would have been obvious to one of ordinary skill in the art at the time of the invention to indicate no ad content to be associated with the media file as in Strietzel in order to provide the user with an option to receive the content with or without advertisement associated with it, as taught in Strietzel.

Regarding claims 39 and 112, Strietzel wherein said ad file includes user interactive content (see col. 4 lines 14-33, col. 10 lines 1-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to include interactive content in order to allow the user to receive additional information about the product or to provide an option for the user to make a purchase.

Regarding claims 40, 42, 43 and 113, Strietzel teaches receiving a media file from said user; associating an ad requirement with said media file; and providing said media file to another user; whereby the content of said media file can be presented to said other user with ad file content; wherein at least a portion of said media file is received via a peer-to-peer transfer (see 16 lines 57 to col. 17 line 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to register the user of Knepper to act as a content provider, as in Strietzel, in order to make the content available to other registered users content created by the user or for which the user owns copyrights, as taught in Strietzel.

Claims 15, 16, 68, 69 and 86-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper further in view of Eyer et al. (US 6,588,015).

Regarding claims 15, 16, 68, 69, 86-88, Knepper does not specifically teach wherein said step of presenting said ad file content to said user includes ensuring that said ad file content is presented in its entirety include disabling media player playback controls, it is taught in Eyer (see col. 6 lines 50-61, col. 16 lines 46-59, col. 18 lines 48-54). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the control in Knepper as in Eyer for the intended purpose of making sure that the user or viewer listens or views the advertising message paid by the advertiser. It would have been obvious to one of ordinary skill in the art to also control the volume so that the viewer would listen to the message.

Claims 117-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper further in view of Dunstan et al. (US 7,400,729 B2).

Regarding claims 117-122, Knepper does not specifically teach releasing media file from a secure form using an access key and resecuring said media file using a new access key, it is

taught in Dunstan (see col. 1 lines 6-67, col. 6 lines 19 to col. 7 line 13). It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt the digital content of Knepper, as in Dunstan, in order to secure delivery of the digital content by providing the content to only authorized customers, as taught in Dunstan.

Response to Arguments

Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wiser et al. (US 7,263,497 B1) teaches secure online music distribution.

Novak et al. (US 2002/0138593 A1) teaches digital rights management to secure distribution and to disable illegal distribution of paid content through peer-to-peer file exchange.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622